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| 09/935,668      | 08/24/2001  | Yasushige Nakamura   | 011071              | 1050             |

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EXAMINER

NOTE, JANIS L

ART UNIT PAPER NUMBER

1756

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/935,668

**Applicant(s)**

NAKAMURA ET AL.

**Examiner**

Janis L. Dote

**Art Unit**

1756

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 7/12/04.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-7,9-11,13 and 14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-7,9-11,13 and 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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1. A request for continued examination (RCE) under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicants' submission filed on Jul. 12, 2004, has been entered.

2. The examiner acknowledges the amendments to claims 1, 7, and 11 filed in the amendment on Jun. 14, 2004 (Amdt061404), which was entered upon the filing of the RCE. Claims 1, 3-7, 9-11, 13, and 14 are pending.

3. The rejection of claims 1, 3-7, 9-11, 13, and 14 under 35 U.S.C. 112, first paragraph, set forth in the office action mailed Jan. 12, 2004 (CTFR011204, paragraph 4, has been withdrawn in response to the amendments to claims 1, 7 and 11 filed in Amdt061404.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 5 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 is indefinite in the phrase "at least one of . . . the second polyester resin is a polyester resin originating from an alkylene oxide adduct of bisphenol A represented by . . . formula (I) [recited in instant claim 5]" for lack of unambiguous antecedent basis. Instant claim 1, from which claim 5 depends, requires that the second polyester resin be a polymerization product of polyoxypropylene (2.2)-2,2-bis(4-hydroxy-phenyl)propane and polyoxyethylene (2.2)-2,2-bis(4-hydroxy-phenyl)propane. The "alkylene oxide adduct" of formula (I) recited in claim 5 is broader than the two narrower species recited in instant claim 1. It is not clear whether the "alkylene oxide adduct" recited in claim 5 refers to the two narrower species recited in instant claim 1 or to other alkylene oxide adducts that may be present in the second polyester resin. If the latter, claim 5 is indefinite because it fails to further limit claim 1, in violation of 35 USC 112, fourth paragraph.

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Claim 6 is indefinite in the phrase "[t]he imaging color toner according to claim 1, wherein the color toner is used in an electrophotographic imaging process." Claim 6 provides for the use of the color toner, but, since the claim does not set forth any steps involved in the process, it is unclear what methods applicants intend to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claim 6 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd. App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 1, 3-7, 9-11, 13, and 14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1, 7, and 11, and claims dependent thereon, recite a polyester resin comprising a "second polyester resin being a polymerization product of polyoxypropylene (2.2)-2,2-bis(4-hydroxy-phenyl)propane, polyoxyethylene (2.2)-2,2-bis(4-hydroxy-phenyl)propane and terephthalic acid in the absence of a crosslinking component."

The originally filed specification does not provide an adequate written description of the second polyester resin recited in the instant claims. Throughout the originally filed specification, the specification discloses only a second non-linear polyester resin having a Tsp of not lower than 80°C and lower than 110°C. See the originally filed specification,

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page 4, line 36, to page 5, line 1; page 8, lines 11-16 and 24-31; and page 10, lines 8-10. The term "linear polymer" is usually defined as polymers that are not branched, cross-linked, or of a network structure. See Polymer Technology Dictionary, page 225. In light of the definition of the term "linear polymer," the term "non-linear polymer" thus refers to polymers that are branched, cross-linked, or of a network structure. There is no disclosure in the originally filed specification that the second non-linear polyester is a polymerization product obtained "in the absence of a crosslinking component" as recited in the instant claims. The originally filed specification in Table 1 at page 24, discloses only two particular polyester resins, 2-2 and 2-3, that meet the softening point Tsp and acid value requirements recited in claims 1, 7, and 11. Both resins are obtained by reacting polyoxypropylene (2.2)-2,2-bis(4-hydroxy-phenyl)propane and polyoxyethylene (2.2)-2,2-bis(4-hydroxy-phenyl)propane in a 1:1 molar ratio, with terephthalic acid. Resins 2-2 and 2-3 also have a Tsp of 80°C and 100°C, respectively, and an acid value of 7.5 and 10.6, respectively. The second polyester resin recited in instant claims 1, 7, and 11 is not limited to the narrower disclosed resins 2-2 and 2-3, because it includes polyester resins that are not related to resins 2-2 and 2-3, such as, for

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example, polyesters that are obtained by other monomers not present in the two particular disclosed resins, or polyesters that do not have a Tsp of 80 or 100°C, the Tsp value of resins 2-2 and 2-3, respectively.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janis L. Dote whose telephone number is (571) 272-1382. The examiner can normally be reached Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Mark Huff, can be reached on (571) 272-1385. The central fax phone number is (703) 872-9306.

Any inquiry of papers not received regarding this communication or earlier communications should be directed to Supervisory Application Examiner Ms. Claudia Sullivan, whose telephone number is (571) 272-1052.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JLD

Jul. 21, 2004

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